

The opinion in support of the decision being entered today was **not** written for publication in a law journal and is **not** binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALFREDO A. CIOTOLA

Appeal No. 98-1523
Application No. 08/705,744

ON BRIEF

Before ABRAMS, MCQUADE, and CRAWFORD, Administrative Patent Judges.

CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 18 through 27, which are all of the claims pending in this application. Claims 1 through 17 have been canceled.

The appellant's invention relates to a mechanical seal having connector clips between the stationary components of the seal and a stationary housing.

An understanding of the invention can be derived from a reading of exemplary claim 18, which appears in the appendix to the appellant's brief.

The prior art

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Azibert et al (Azibert '977) 2, 1986	4,625,977	Dec.
Malmstrom 24, 1971	3,601,412	Aug.
Warner et al (Warner) 1991	4,989,882	Feb. 5,
Radosav et al (Radosav) 1992	5,114,163	May 19,
Azibert et al (Azibert '496) 11, 1993	5,209,496	May
Duffee et al (Duffee) 1994	5,294,132	Mar. 15,

The rejections

Claims 18, 20 and 23 through 25 and 27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Warner.

Claims 18, 20, 23 through 25 and 27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Azibert '977.

Claims 18 through 27 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Azibert '496.

Claims 18, 20, 23 through 25 and 27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Radosav.

Claims 18, 20, 23 through 25 and 27 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Duffee.

Claims 20, 24, 25 and 27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Malmstrom.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's final rejection (Paper No. 8, mailed May 19, 1997) and answer (Paper No. 13, mailed November 25, 1997) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 12, filed September 30, 1997) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the

examiner. As a consequence of our review, we make the determinations which follow.

We initially note that all of the rejections are under 35 U.S.C. § 102. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

We turn first to the examiner's rejection of claims 18, 20, 23 through 25 and 27 as being unpatentable under 35 U.S.C.

§ 102(b) as being anticipated by Warner. The examiner is of the opinion that all the features of the claimed invention

are disclosed in Warner and illustrated in Fig. 1 and calls attention to clip 52.

The appellant argues that Warner does not disclose a clip but rather a flange and that Warner does not disclose a clip pin. Appellant's specification states that the connector clips 138 connect the stationary components of the seal to the stationary housing and comprise a radial extension 142 having a seal end 144 and a bolt end 146. The bolt end 146 has a bolt end opening 148 to receive the bolt 140 (Specification at page 18). Appellant's specification does not define the clip further. However the College Standard Dictionary, (Funk & Wagnalls Company, 1981) p. 230, defines a clip as "any appliance that clasp, grips or holds fast." The flange 52 of Warner firmly holds the seal housing 50 to the machine wall 56. Flange 52 includes a radial extension (the portion adjacent the screw 54) on a bolt end and a seal end (adjacent seal housing 50) (Fig. 1). The flange 52 also has an opening to receive a bolt. As such, although the element 52 is called a flange in the Warner specification, the flange "reads on" the clip recited in claim 18.

In regard to the appellant's argument that Warner does not disclose a clip pin, we note that claim 18 does not recite a clip pin. As such, this argument is not persuasive because it is not commensurate in scope with the actual scope of claim 18.

In view of the foregoing, we will sustain the examiner's rejection of claim 18 under 35 U.S.C. § 102(b) as being unpatentable as anticipated by Warner. The decision of the examiner to reject claims 20 and 23 through 25 and 27 under 35 U.S.C. § 102(b) is also sustained since the appellant has not addressed the separate patentability of these claims. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987).

We turn next to the examiner's rejection of claims 18, 20, 23 through 25 and 27 as being unpatentable under 35 U.S.C. § 102(b) as anticipated by Asibert '977. It is the examiner's opinion that Azibert '977 clearly discloses all features of the claimed invention, as illustrated by Fig. 4.

The appellant argues that Azibert '977 does not disclose an axial extension on the clip located adjacent the bolt or a clip pin.

We do not agree that Azibert '977 does not disclose an axial extension adjacent the bolt, we agree with the examiner that:

As clearly shown in fig. 4, element (118) has a seal end (at 122) that projects radially and engages stationary seal member (86), and a bolt end that lies radially outward therefrom. The "bolt end" clearly includes the claimed axial extension. The bolt end clearly having a greater axial dimension than the seal end. The bolt end also include a bolt hole, part of the extension lying above the bolt hole(s) and part lying below the bolt hole. The extension therefore clearly being "adjacent" to the bolt and bolt hole since it adjoins and at least partially surrounds the bolt (more than 180 degrees).
[Examiner's Answer at page 5]

In regard to the argument that Azibert '977 does not disclose a clip pin, we note again that claim 18 does not recite a clip pin. As such, we do not find this argument persuasive.

In view of the foregoing, we will sustain the examiner's rejection of claim 18 as being unpatentable as anticipated by Azibert '977. We will likewise sustain the examiner's rejection of claims 20, 23 through 25 and 27 as appellant has not argued

the separate patentability of these claims and therefore, claims 20, 23 through 25 and 27 stand or fall with claim 18.

See Nielson, 816 F.2d at 1572, 2 USPQ2d at 1528.

We turn next to the examiner's rejection of claims 18 through 27 under 35 U.S.C. § 102(e) as being unpatentable as anticipated by Azibert '496. It is the examiner's opinion that Azibert '496 discloses all the features of the claimed invention as illustrated in Figures 4 and 4a.

Appellant argues that Azibert '496 does not disclose an axial extension from the radial seal surface of the clip at the bolt end nor a clip pin.

We do not agree with the appellant. In Fig. 4a, the clip or tab 72 has a seal end which engages the seal gland 70 at 74. In addition, the bolt end of the clip (See Fig. 2b) has an axial extension extending from the radial seal surface.

For the foregoing reasons, we will sustain the examiner's rejection of claim 18. We will also sustain the examiner's rejection of claims 19, 20, 23 through 25 and 27 as the appellant has failed to argue the separate patentability of these claims. See Nielson, 816 F.2d at 1572, 2 USPQ2d at 1528.

Claims 21, 22 and 26 recite a clip pin extending from the seal surface. The examiner is of the opinion that projection 73 depicted in Fig. 4a is a clip pin. We do not agree. The College Standard Dictionary, at 861 defines a pin as "a short stiff piece of wire, with a sharp point and a rounded, usually flattened head." In our view a person skilled in the art would not consider the projection 73 to be a pin. Therefore, we will not sustain the rejection as it is directed to claims 21, 22 and 26.

We turn next to the examiner's rejection of claims 18, 20, 23 through 25 and 27 as unpatentable as anticipated by Radosav. In the examiner's opinion, Radosav discloses all features of the claimed invention as illustrated in Figs 2, 4a and 9. The examiner specifically points to clips 36, 60 and 60'.

The appellant argues that Radosav does not disclose "clips" but plates. The appellant also argues that the plates have no radial extensions and that Radosav does not disclose clip pins.

As is depicted in Fig. 2, Radosav discloses an element 36 between the stationary seal component (40) and bolts to hold

the stationary seal component firmly to the housing 24. Therefore, it is our opinion that Radosav does disclose a clip as broadly claimed. In addition, there is also an axial extension from the radial seal surface (which engages seal component 40). We are not persuaded by appellant's argument that Radosav does not disclose clip pins because claim 18 does not recite a clip pin. Therefore, this argument is not commensurated with the actual scope of claim 18.

In view of the foregoing, we will sustain the examiner's rejection of claim 18 as being unpatentable under 35 U.S.C. § 102(b) as anticipated by Radosav. We will also sustain the rejection as it is directed to claims 20, 23 through 25 and 27 as the appellant has not argued the separate patentability of these claims. See Nielson 816 F.2d at 1572, 2 USPQ2d at 1528, (Fed. Cir. 1987).

We turn now to the examiner's rejection of claims 18, 20, 23 through 25 and 27 as being unpatentable under 35 U.S.C. § 102(e) as anticipated by Duffee. It is the examiner's opinion that Duffee discloses the claimed invention as claimed and that this is illustrated in Fig. 2.

The appellant argues that Duffee does not disclose clips and that the flange that is disclosed has no axial extension from the seal surface at the bolt end.

We agree with the appellant that Duffee does not disclose an axial extension from the seal surface at the bolt end. Although, the gland or plate 20 does interconnects the seal to a housing 14 and as broadly claimed is a clip, and element 20 does indeed include an axial extension 22, this extension is not disposed at the bolt end. Rather the axial extension is from the radial seal surface at the seal end.

In view of the foregoing, we will not sustain the examiner's rejection of claim 18 and claim 23 dependent therefrom. In addition, we will not sustain the rejection of claims 20, 24, 25 and 27 under 35 U.S.C. § 102(e) as being unpatentable as anticipated by Duffee as claims 20 and 25, from which claim 24 and 27 depend, each recite an axial extension from the radial seal surface at the bolt end.

We turn finally to the examiner's rejection of claims 20, 24, 25 and 27 as being unpatentable under 35 U.S.C. § 102(b) as anticipated by Malmstrom. The examiner is of the opinion that Malmstrom discloses all the features of the claimed

invention as clearly illustrated in Figs. 5a, 5b, 8a, 8b, 9, and 14. Figures 5a, 5b, 8a, 9 and 14 depict different embodiments of the Malmstrom device (Col. 1, lines 60-72). Anticipation is not established if in reading a claim on something disclosed in a reference, it is necessary to pick, choose and combine various portions of the disclosure not directly related to each other by the teachings of the reference. In re Arkley, 455 F.2d 586, 587-88, 172 USPQ 524, 526 (CCPA 1972).

In view of the foregoing, we will not sustain the examiner's rejection of claims 20, 24, 25 and 27 under 35 U.S.C. § 102(b) as being anticipated by Malmstrom.

In summary:

(1) The examiner's 102(b) rejections of claims 18, 20, 23-25 as anticipated by (A) Warner (B) Azibert '977, and (C) Radosav are sustained.

(2) The examiner's 102(e) rejection of claims 18-20, 23-25 and 27 as anticipated by Azibert '496 is sustained.

(3) The examiner's 102(e) rejection of claims 21, 22 and 26 as anticipated by Azibert '496 is not sustained.

(4) The examiner's 102(b) rejection of claims 18, 20, 23-25 and 27 as anticipated by Duffee is not sustained.

(5) The examiner's 102(b) rejection of claims 20, 24, 25 and 27 as anticipated by Malmstrom is not sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. MCQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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